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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,164	07/19/2001	Marguerita Lim-Wilby	IN01192	8821

24265 7590 01/05/2004

SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-1, 1990)
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EXAMINER

AUDET, MAURY A

ART UNIT	PAPER NUMBER
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1654

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Please find below and/or attached an Office communication concerning this application or proceeding.



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09909164

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Commissioner for Patents

Response to Arguments

Applicant's amendment filed 9/22/03 is acknowledged. Claims 1-19, 21, and 29 are pending, and claims 20, 22-28, and 30 remain withdrawn from consideration (but have not yet been cancelled). Applicant's arguments, filed 09/22/2003, with respect to the rejection of claims 1-19, 21, and 29 under 35 U.S.C. "s 101 and 112 1st have been fully considered and are persuasive. Therefore, these rejections have been withdrawn.

Response to Amendment

However, the reply filed on 09/22/2003 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Applicant has failed to amend the claims commensurate in scope with the election of Group I, claims 1-19, 21, and 29, as drawn to SEQ ID NOS: 5-13 and 42-47. Only claim 6 has been amended, and no claims have been amended to narrow the scope of the claims to the elected invention. See 37 CFR 1.111. Since the above-mentioned reply appears to be bona fide, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

However, pending claims 1-19, 21, and 29 (and 28, see below) would be allowable if the claims were amended to the following:

Claim 1 (amended): A compound, including enantiomers, stereoisomers, rotomers and tautomers of said compound, and pharmaceutically acceptable salts, solvates or derivatives thereof, with said compound having the general structure shown in Formula 1:

[Compound Structure]

Formula I

or a pharmaceutically acceptable derivative thereof, wherein the compound is selected from the group consisting of SEQ ID NOS: 5-13, and 42-47.

Furthermore, dependant claims 2-18 must be amended to be within the scope of claim 1.

In re Ochiai/Brouwer Rejoinder

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

In view of In re Ochiai/Brower, the Examiner is also willing to rejoin claim 28, drawn to a method of making the compounds of claim 1 (but not the claims drawn to methods of use in this case, due to substantial issues under 35 U.S.C. ' 112 1st/2nd). However, like the other dependent claims, claim 28 must be amended to be within the scope of claim 1.

Additionally, withdrawn claims 20, 22-27, and 30 must be cancelled (along with claim 28, if not pursued for rejoinder).

Allowable Subject Matter

Elected compounds SEQ ID NOS: 5-13 and 42-47, as drawn to the elected invention of Group I, were found to be free of the prior art. Therefore, claims 1-19, 21, and 29 would be allowable if amended (as suggested above) to be limited commensurate in scope with the elected SEQ ID NOS: 5-13 and 42-47.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maury Audet whose telephone number is 703-305-5039. The examiner can normally be reached from 7:00 AM – 5:30 PM, off Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached at 703-306-3220. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-1234 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

MA

December 29, 2003

Herbert J. Lilling
HERBERT J. LILLING
PATENT EXAMINER
GROUP 1600 ART UNIT 1651